Supreme Court, U.S.
FILED
DEC 7 2001
CLERK

No. 01-677

In The

Supreme Court of the United States

PTI TECHNOLOGIES, INC.,

Petitioner,

v.

PALL CORPORATION,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

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QUESTION PRESENTED

Whether the doctrine of prosecution history estoppel bars a patentee from using the doctrine of equivalents to recapture subject matter that was surrendered in order to secure allowance of the claims.

PARTIES TO THE PROCEEDING BELOW

In addition to those identified by Petitioner, the parties to the proceeding below include respondent Pall Corporation. Respondent Pall Corporation is erroneously identified as Pall Corporation Technologies, Inc. in Petitioner's case caption.

Pursuant to this Court's Rule 29.6, Respondent Pall Corporation states that it has no parent corporation and that no publicly held companies own 10 percent or more of its stock.

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BRIEF IN OPPOSITION

Respondent Pall Corporation ("Pall") respectfully submits that a writ of certiorari should not issue in this case. The Court of Appeals for the Federal Circuit, affirming the district court's grant of summary judgment of noninfringement, correctly held that prosecution history estoppel bars Petitioner PTI Technologies, Inc. ("PTI") from asserting that the PTI patent in suit covers the accused Pall filters.

Contrary to what is asserted by PTI, there are significant differences between this case and the issues raised in the petition of certiorari granted with respect to the Federal Circuit's decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558 (Fed. Cir. 2000) (*en banc*), *cert. granted*, ___ U.S. ___, 121 S.Ct. 2519 (June 18, 2001) (No. 00-1543) ("*Festo*"). In particular, independent of the application of *Festo*, this case involves a classic basis for prosecution history estoppel under pre-*Festo* law. Namely, an amendment and accompanying argument were made during prosecution to avoid the prior art, thereby creating an estoppel. Now, in asserting its patent against Pall, PTI attempts to recapture subject matter surrendered to secure allowance of the patent.

The application of the doctrine of prosecution history estoppel in this case is amply supported not only by *Festo* but also by precedents of this Court extending back over one hundred years, as well as those of the Federal Circuit since its inception. As such, this case does not raise any

unique or controverted legal issues relating to the doctrine of prosecution history estoppel that require review by this Court. Thus, PTI's petition should be denied.

STATEMENT OF THE CASE

The facts relevant to the Court's consideration of the question presented by PTI illustrate that this case turns on the unremarkable proposition that a party should be prevented from arguing that its claims mean one thing in order to secure allowance of the patent but then asserting they mean something else during subsequent litigation proceedings.

One of the key limitations in the PTI patent, inserted in order to gain allowance of the claims, calls for "net supporters made of PFA, FEP or EPE." The district court concluded, and the Federal Circuit agreed, that the claims require the net supporters to be made of 100% of one of the recited thermoplastic fluorocarbon resins. Pet. App. 10a, 34a.[1]

The accused infringing Pall device is an all-fluoropolymer filter having a PTFE membrane and support and drainage layers arranged on each side of the membrane. Pet. App. 10a-11a. PTI alleges that these support and drainage layers correspond to the claimed net supporters. However, in contrast to the plain language of the patent claims, the support and drainage layers in the Pall filters contain at least 60% PTFE fibers. On this basis,

[1] Page references to the appendix attached to Petitioner's brief are indicated as "Pet. App. ___."

both the district court and the Federal Circuit found that the accused Pall filters did not literally infringe the PTI patent. Pet. App. 11a, 38a.

PTI has not challenged the construction of the claims on appeal and concedes that there is no literal infringement. Pet. App. 10a-11a. PTI is now relying solely on infringement under the doctrine of equivalents. Both the district court (applying pre-*Festo* legal precedent) and the Federal Circuit held that PTI was barred by prosecution history estoppel from asserting that the Pall support and drainage layers were the equivalent of the claimed net supporters due to a claim amendment and accompanying argument made in response to a prior art rejection. Pet. App. 11a, 39a.

The claims of the PTI patent as originally filed recited "net supporters made of a thermoplastic fluorocarbon resin." Pet. App. 11a, 36a. The claims were rejected over a prior art patent showing PTFE net supporters. Pet. App. 36a. In response, the patentees limited the claims to require "net supporters made of PFA, FEP or EPE." In the remarks accompanying the amendment, it was emphasized that "[a]ll of the constituents of the filter element now claimed are not the same. The membrane material is PTFE but the net, seal, etc. are not. . . . " Pet. App. 11a. The plain import of this argument was to distinguish the prior art patent on the basis that it showed a net supporter containing PTFE, while the claimed invention now excluded net supporters containing PTFE.

Based on this amendment and its accompanying argument, both the district court and the Federal Circuit held that PTI was barred by prosecution history estoppel

from recapturing coverage of Pall's "net supporters" which contained 60% PTFE under the doctrine of equivalents.

REASONS FOR DENYING THE PETITION

In sharp contrast to a significant issue raised in *Festo*, there is no question that in this case the amendment and accompanying argument creates prosecution history estoppel with respect to the net supporters limitation under both pre-*Festo* and post-*Festo* law. Specifically, the patentees' amendment and accompanying argument narrowed the claims in order to overcome the Patent Office's rejection of the claims based on the prior art. This is the classic basis for application of prosecution history estoppel. *See Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136 (1942) ("[I]t has long been settled that recourse may not be had to [the doctrine of equivalents] to recapture claims which the patentee has surrendered by amendment."). Moreover, the Federal Circuit has consistently held that an argument made during prosecution can create an estoppel. *See Cortland Line Co. v. The Orvis Co., Inc.*, 203 F.3d 1351, 1360 (Fed. Cir. 2000) (holding that the patentee's arguments during prosecution "evinc[e] a clear and unmistakable surrender"); *Texas Instruments, Inc. v. United States Int'l Trade Comm'n*, 988 F.2d 1165, 1174 (Fed. Cir. 1993) ("Unmistakable assertions made by the applicant to the Patent and Trademark Office . . . may operate to preclude the patentee from asserting equivalency."). The application of prosecution history estoppel in cases such as this one is well-established and therefore unworthy of certiorari regardless of the outcome in *Festo*.

Thus, the only remaining issue presented by this case that could be influenced by how the Court resolves *Festo* is the scope of the estoppel that applies to the net supporters claim limitation. Obviously, if the Court affirms the ruling in *Festo* that no range of equivalents is available to a claim limitation when prosecution history estoppel applies (i.e., a complete bar), then PTI's petition should be denied. However, no matter whether the complete bar of *Festo* or a so-called flexible bar is applied, it is well established that, at a minimum, PTI should be barred from recapturing coverage of net supporters containing PTFE, and in particular, a net supporter containing at least 60% PTFE, since it disclaimed such coverage to secure allowance of the patent.

Both this Court and the Federal Circuit have long held that a patent owner cannot use the doctrine of equivalents to recapture subject matter that was disclaimed or surrendered during prosecution in order to secure allowance of the claims. *See, e.g., Smith v. Magic City Kennel Club, Inc.*, 282 U.S. 784, 790 (1931) ("[W]here a patentee has narrowed his claim, in order to escape rejection, he may not 'by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments, which amount to disclaimer.' "); *Southwall Technologies, Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1579 (Fed. Cir. 1995) ("Thus, prosecution history estoppel limits the range of equivalents . . . by preventing recapture of subject matter surrendered during prosecution of the patent."). As the outcome of this case does not depend on the application of the complete bar approach set forth in *Festo*, this Court should deny certiorari.

PTI's petition concedes that this case presents no issues of certiorari, independent of the prosecution history estoppel issues already present in *Festo*. Thus, while the Court may opt to delay ruling on PTI's petition until it decides *Festo*, this case merits no additional consideration by the Court.

CONCLUSION

For the foregoing reasons, Pall respectfully requests that PTI's petition for a writ of certiorari be denied. Alternatively, if the Court resolves *Festo* in a manner that does not definitively resolve PTI's petition, Pall respectfully requests that the Court delay ruling on the petition until the parties have had sufficient time to submit supplemental briefs in accordance with Supreme Court Rule 15.

If the Court nevertheless decides that its ruling in *Festo* compels granting PTI's petition, the Court may grant, vacate and remand this case for further consideration and disposition by the Federal Circuit in light of the prosecution history estoppel principles established by the Court as well as the other grounds that support the

district court's grant of summary judgment of non-infringement.

Respectfully submitted,

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Date: December 7, 2001